

Notice of Allowability

Application No.

09/920,017

Examiner

Celia Chang

Applicant(s)

HAMILTON ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 03/28/06 amendment.
2. ☒ The allowed claim(s) is/are 9, 13 and 83.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

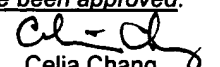
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☒ Other drawings have been approved.


Celia Chang
Primary Examiner
Art Unit 1625

DETAILED ACTION

1. Amendment and response filed by applicants dated Mar. 28, 2006 have been entered and considered carefully. Claims 1-8, 10-12, 14-82 have been canceled. Claims 9, 13, 83 are pending.

2. ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Claim 1, line 2, after the term (i), insert, --an effective amount of --;

Claim 83, line 2, after the term (i), insert, --an effective amount of --.

Support for the above amendment is found on pages 66-67 wherein composition containing effective amount of claim 83 and closely related compounds have been shown to be effective in neuronal regeneration after induction of MPTP-derived lesions.

3. ***Reason for Allowance***

The following is an examiner's statement of reasons for allowance:

Applicants have amended the claims to a very limited subgenus of compounds for which the descriptive and enabling support are found on pages 29-30 with specific support of compounds disclosed on pages 54-56 wherein X is O, n is 1, and the R1 moieties being C₄₋₉ (see compounds 3, 21-22 p.54-55), carbocycle i.e. p.30 lines 1-5, and heterocycle i.e. p.32 and p.55 compound 14. The composition of claim 83 has been shown to be effective in neuronal regeneration after induction of MPTP-derived lesions (see p. 66-67). By inserting the quantitative relationship between the active ingredient and the carrier, all 112 issues have been obviated. The 112 issues of record have been obviated by cancellation and amendments to the claims. The 102(e) and (f) rejection and the obviousness type double patenting have been obviated by applicants amendment to the particular subgenus and the submission that the instantly limited scope was not

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described by SN 60/059,905 (see response p. 11). The rejection of claims 1-3, 5-7, 9-11 and 13 under 35 USC 103(a) over Hamilton '031, '441, '455, '510 in view of Bungaard or Silverman further in view of Li '187, '544 and Patani et al. is dropped in view of the acceptable arguments presented by applicants on page 9 of the response that there is no suggestion for an ester drug to be reversed to its acid in the art of record. Claims 9, 13, 83 are allowed.


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jun 13, 2006


Celia Chang
Primary Examiner
Art Unit 1625